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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,203	01/10/2002	Rick L. Allison	1322/84	9749

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HU, JINSONG

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/044,203	ALLISON ET AL.
	Examiner	Art Unit	
	Jinsong Hu	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 May 2006</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-40</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/8/06</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. The affidavit filed on 5/8/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Murai reference (prior art reference for previous office action).

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Murai reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The attorney's time record only indicated the time of conferences between the inventor and the attorney for an application named as "Methods And System For Providing Gateway Location Register Functionality At A Network Routing Node" (the title is different from the tile of 10/044,203). Applicant does not provide any documents to prove that the concepts have been established prior to the effective date of the Murai reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Murai reference to either a constructive reduction to practice or an actual reduction to practice. The e-mail and invoice provided by applicant indicated the time (11/26/01 – 1/9/02) for the discussions made between inventor and the attorney, which is later than the effective date of the Murai reference.

Furthermore, the content of the screenshot does not disclose the steps of extracting

mobile subscriber information from a first signaling message, caching the mobile

subscriber information, and using the cached information in the processing and routing

of subsequent signaling messages transmitted mobile subscriber by the HLR or the

VLR relating to the mobile subscriber. The screenshot also indicated that the content

was created on 10/12/01, which is later than the effective date of the Murai reference.

Accordingly, the affidavit is ineffective to overcome the Murai reference.

2.   Claims 1-40 are presented for examination. Claims 1, 15 and 29 have been

amended. Claims 39 and 40 are newly added claims.

3.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Applicant's arguments with respect to claims 1-40 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-12 and 15-40 are rejected under 35 U.S.C. 102(e) as being anticipated

by Kowarsch (US 2004/0132449).

6.   As per claims 1, 5-6 and 37, Kowarsch teaches the invention as claimed a

method for mobile subscriber location management and for routing messages in a

mobile communications network environment, the method comprising:

in a routing node separate from a home location register (HLR) and a visitor

location register (VLR) and being located in a communication path between the HLR

and the VLR [115, Fig. 1; pars. 129-132]:

receiving signaling messages transmitted between an HLR and a VLR related to

the location or subscription of a mobile subscriber, extracting mobile subscriber

information from a first signaling message, caching the mobile subscriber information

[pars. 86-88 &129-130]; and

using the cached information in the processing and routing of subsequent

signaling messages transmitted by the HLR or the VLR relating to the mobile subscriber

[pars. 131, 132 & 136].

7.   As per claims 2-3 and 9, Kowarsch teaches the step of receiving signaling

messages includes receiving a mobile application part (MAP) UpdateLocation message

and a mobile application part (MAP) InsertSubscriberData message [pars. 147 & 148].

8.   As per claim 4, Kowarsch teaches the step of extracting information from the first

message includes extracting a mobile switching center (MSC) identifier that identifies an

MSC serving the mobile subscriber [pars. 126, 131 & 147].

9.   As per claims 7 and 8, Kowarsch teaches the step of caching the mobile

subscriber information includes storing the information in a visitor location cache (VLC)

and caching the information includes storing the information in a home location cache

(HLC) [pars. 85 & 125].

10.   As per claim 10, Kowarsch teaches the step of using the cached information in

the processing and routing of subsequent mobile signaling messages includes using the

cached information to generate and route a ProvideRoamingNumber_Ack message on

behalf of a VLR in response to a received ProvideRoamingNumber message [pars. 125

& 126].

11.   As per claims 11-12, Kowarsch teaches the step of using the cached information

in the processing and routing of subsequent mobile signaling messages includes using

the cached information to process and route a received CancelLocation message [pars.

185 & 186].

12.   As per claims 15-28, since they teaching same limitations as claims 1-12 form

different prospectors (router side and HLR side), they are rejected under the same basis

as claims 1-12 above.

13.   As per claims 29-36 and 38, since they are system claims of claims 1-12, they

are rejected under the same basis as claims 1-12 above.

14.   As per claim 39, Kowarsch teaches the invention as claimed including a method

for mobile subscriber location messages in a mobile communications network

comprising:

in a routing node separate from a home location register (HLR) and a visitor

management and for routing environment, the method location register (VLR) and being

located in a communication path between the HLR and the VLR [115, Fig. 1; pars. 129-

132]:

receiving a signaling message directed toward the HLR originating from

the VLR related to a change in location of a mobile subscriber [par. 152];

generating a response message to the VLR on behalf of the HLR using

cached information related to the mobile subscriber without forwarding the signaling

message to the HLR [pars. 150, 151, 153-156]; and

sending the response message to the VLR [par. 157].

15.   As per claim 40, since the claim discloses the same limitation as claim 39 from

different prospector [i.e., behalf of HLR and behalf of VLR] and Kowarsch also teaches

the router could processes the request behalf of VLR [pars. 89-90], the claim is rejected

for the same basis as claim 39 above.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kowarsch (US 2004/0132449) as applied to claims 1-12 and 15-40 above, in view

of Official Notice.

18.   As per claims 13 and 14, Kowarsch teaches the invention substantially as

claimed in claim 1. Kowarsch also teaches a signaling/IP gateway [col. 5, lines 14-17].

Kowarsch deos not specifically teach the signaling network is SS7. However, official

Notice is taken that the SS7 is well known in the art for setting up a call via high speed

switched connection. One of ordinary skill in the art would have been motivated to

modify Kowarsch's system to increase the efficiency of the system.

Conclusion

19.   Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant

is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

21.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jinsong Hu whose telephone number is (571) 272-3965.

The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone

number for the organization where this application or proceeding is assigned is (571)

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Jinsong Hu

August 2, 2006

VIET D. VU
PRIMARY EXAMINER